

REMARKS

This communication is in response to the final Official Action mailed February 10, 2006. With the present response, the claims that remain in this application are claims 31-46, 52-70 and 72.

Reexamination and reconsideration of the above-identified application, and in light of the remarks that follow are respectfully requested. Because the present claims are believed to be in condition for immediate allowance over the newly-cited combination of prior art, including newly-cited Ohara and Ellis references, it is submitted that good and sufficient cause exists for the entry for this amendment in accordance with 37 CFR § 1.116.

In the Official Action, the Examiner has made the following rejections:

1) Claims 31-33, 40, 40-44, 46-49, 51-52, 58-60, 62-65 and 67-72 have been rejected as obvious under § 103(a) over Browne et al. ("Browne") in view of Lenihan et al. ("Lenihan") and further in view of Suga et al. ("Suga") and further in view of newly-cited U.S. Patent No. 6,292,618 to Ohara et al. ("Ohara") (Official Action ¶ 3);

2) Claims 45, 61 and 66 have been rejected as obvious under § 103(a) over Browne in view of Lenihan and further in view of Suga and further in view of newly-cited Ohara and further in view of Yuen et al. ("Yuen") (Official Action ¶ 4);

3) Claims 35-37, 39, 53-55 and 57 have been rejected as obvious under § 103(a) over Browne in view of Suga and further in view of newly-cited Ohara (Official Action ¶ 5);

4) Claim 38 has been rejected as obvious under § 103(a) over Browne in view of Suga and further in view of newly-cited Ohara and further in view of Yuen (Official Action ¶ 6); and

5) Claim 56 has been rejected as obvious under § 103(a) over Browne and further in view of Yuen (Official Action ¶ 7).

However, as to the independent claims (31, 35, 41, 52, 53, 58, 63, 68, 69 and 72), the following prior art was applied by the Examiner, including a newly-cited reference to Ellis et al. ("Ellis"):

Combined References	Independent Claims
Browne, Lenihan, Suga, Ohara	31, 41
Browne, Suga, Ohara	35, 53, 68, 69
Browne, Lenihan, Suga, Ellis	52
Browne, Suga, Ellis	58, 63, 72

As discussed in detail below, the newly cited prior art, even if combined in a manner as proposed by the Examiner, does not teach, suggest or disclose the inventions of the present claims.

Independent Claims 31, 35, 41, 53, 68 and 69

As to independent claims 31, 35, 41, 53, 68 and 69, the Examiner applied newly-cited Ohara with either the combination of Browne, Lenihan and Suga or the combination of Browne and Suga. None of these proposed combinations, however, even with the additional of Ohara, discloses or suggests all of the limitations of the claimed invention of independent claims 31, 35, 41, 53, 68 and 69.

Ohara provides a recording and reproducing apparatus that is concerned with the on-screen display that shows the status of the video tape recorder (VTR) and the received channel. Namely, if in the analog mode (analog broadcast), the VTR control circuit 20 sends information on the VTR mode (e.g., stop,

record, playback) and information on the reception channel of the analog tuner 12 to the analog OSD circuit 14 for superimposition. If in the digital mode (the digital broadcast is converted to analog form by decoder 203), the VTR obtains the channel number from the IRD and displays the operation mode of the VTR and obtained channel of the digital broadcast also using analog OSD circuit 15.

Ohara does not disclose or suggest preventing the digital broadcasting signal from being shown when the VTR is in the reproducing mode *depending on when control panel information is displayed or not*. Namely, in the present application, claims 41 and 31 provide in relevant part the following:

Claim 41: "wherein when said external recording apparatus is in the analog recording mode, said display processing circuit prevents the display of the received digital broadcasting signal *only during the displaying of said control panel information*"

Claim 31: "wherein when said external recording apparatus is in the analog reproducing mode, said display processing circuit prevents the display of the received digital broadcasting signal to the user and when said external recording apparatus is in the analog recording mode, said display processing circuit prevents the display of the received digital broadcasting signal *only during the displaying of said control panel information*"

Both claims provide that when the external recording apparatus is in the analog *recording* mode, the display processing circuit prevents the display of the received digital broadcasting signal only during the displaying of the control panel information. Claim 31 adds that when the external recording apparatus is in the analog *reproducing* mode, the display processing circuit also prevents the display of the

received digital broadcasting signal to the user. Similar limitations are presented in independent claims 68 and 69.

The passages of Ohara cited by the Examiner do not disclose this feature. Namely, Col. 2, lines 29-34 relates to the VTR displaying information obtained from the IRD using the same form as the information displayed to the user about the VTR's state, and the user can set the state of the IRD using the picture that would be used to set the state of the VTR. Col. 4, lines 1-18 merely describes the portions of Fig. 1 including change over switches 13 and analog OSD display circuit 15 for superimposing information on the display. Finally, col. 7, lines 26-50, explains that both in the analog mode and digital mode, the analog OSD circuit is used to display the operation mode of the VTR plus the reception channel of the analog broadcast or the digital broadcast. It also begins to explain how the remote control controls the system in analog or digital mode.

Ohara and the other prior art references are not concerned with the problem of preventing user confusion about functions that can or cannot be performed by a receiving apparatus connected to an external recording apparatus via a digital interface when the external recording apparatus is in an analog or digital recording mode. This problem, however, is addressed by the presently claimed invention as shown, for instance, in Figure 4A, which depicts in summary table form that an alarm (indicated by the "O") will be displayed, and a station cannot be selected (indicated by the "x"), when the VCR is in an analog recording mode (such as a stop, recording pause or record mode) and the control panel is displayed.

Thus, the features that the Examiner acknowledged were missing from the combination of Browne, Lenihan and Suga as to claim 31 (Office Action page 5) and from the combination of Browne and Suga as to claim 41 (Office Action page 8), are not

found in Ohara as described above. Thus, the purported combinations fail to present a *prima facie* case of obviousness as to independent claims 31, 41, 68 and 69.

In claims 35 and 53, an alarm message, such as that a new station cannot be selected by the user during digital recording, is displayed during a recording mode of the external reproducing apparatus showing that a recording mode of a program recorded on a recording medium loaded in the external reproducing apparatus indicates an analog recording or a digital recording:

Claim 35: "displaying an alarm message during a recording mode of the external reproducing apparatus showing that a recording mode of a program recorded on a recording medium loaded in the external reproducing apparatus indicates an analog recording or a digital recording."

Claim 53: "a display processing circuit for displaying an alarm message during a recording mode of the external reproducing apparatus showing that the recording mode of the program recorded on the recording medium loaded in said external reproducing apparatus indicates an analog recording or a digital recording."

In the rejection of claim 35, the Examiner noted that the combination of Browne and Suga fail to disclose: "when said when said external recording apparatus is in the analog reproducing mode, said display processing circuit prevents the display of the received digital broadcasting signal to the user and when said external recording apparatus is in the analog recording mode, said display processing circuit prevents the display of the received digital broadcasting signal only during the displaying of said control panel information." (Office Action page 28.) This quoted limitation, however, is in claim 31 but not in claims 35 or 53.

Moreover, this feature of claims 35 and 53 (i.e., displaying an alarm message during a recording mode of the external reproducing apparatus showing that the recording mode

of the program recorded on the recording medium loaded in the external reproducing apparatus indicates an analog recording or a digital recording) is also not disclosed in Ohara, which does not display an alarm message showing that the recording mode of the program recorded on the recording medium loaded in the external reproducing apparatus indicates an analog recording or a digital recording.

Thus, neither claims 35 nor 53 are rendered obvious by the purported combination of Browne, Suga and Ohara.

Independent Claims 52, 58, 63 and 72

As to independent claims 52, 58, 63 and 72, the Examiner applied newly-cited Ellis with either the combination of Browne, Lenihan and Suga or the combination of Browne, and Suga. Again, none of these proposed combinations, however, even with the addition of Ellis, discloses or suggests all of the limitations of the invention of independent claims 52, 58, 63 and 72.

The Examiner admits that the combination of Browne, Lenihan and Suga "fails to explicitly disclose the displaying of an alarm or 'message' if the user selects an input/output that is inconsistent with the mode of the recorder/reproducer." (Office Action pp. 12 (claim 52), 14 (claim 58), 17 (claim 63), and 25 (claim 72).)

However, Ellis discloses an interactive television program guide system that allows users the ability to select programs for recoding on a remote media server. (See ¶ 0013). The passages in Ellis cited by the Examiner do not relate to the feature of claims 52, 58, 63 and 72 of displaying a message about the recording mode of the program recorded when a digital signal is reproduced by the reproducing apparatus and received through the digital interface but unable to be decoded in the decoder. By contrast, Ellis merely discloses that in some

instances, a message (such as "AIR FORCE ONE IS NOT RECORDABLE. PLEASE CHOOSE ANOTHER SELECTION" in Fig. 16) is shown in the Ellis system where a program is copy protected and therefore not recordable by the user when the user indicates a desire to record the program. (§ 0145.) This relates to whether the remote media server can even record the program, not whether an already recorded program loaded in the reproducing apparatus is capable of being decoded by the decoder.

The purported combination of the prior art, even with Ellis, lacks a display processing circuit or displaying step such that when the digital signal reproduced by the reproducing apparatus is not able to be decoded, a message is displayed showing that the program recorded on the recording medium loaded in the external reproducing apparatus was recorded in a recording or compression mode in which the digital signal cannot be decoded. This claimed feature is designed to prevent user confusion when, for example, a tape cassette of a different specification or a digital video signal of a system other than a standard compression format (such as, e.g., MPEG2) has been loaded into the external reproducing apparatus and is reproduced. As noted in the present application:

According to the invention, in the case where the tape cassette in which the transport stream of different specifications or the digital video signal of a system other than the MPEG2 system has been recorded is loaded into the digital video cassette recording/reproducing apparatus 2 and reproduced, an alarm message of "Different system. Cannot be displayed." is displayed. As mentioned above, when the tape cassette which cannot be correctly reproduced is reproduced, the alarm message is displayed on the reproduction picture plane. Therefore, the user can correctly recognize the causes by which the reproduction picture plane cannot be displayed, so that he can take a necessary countermeasure such as to select the proper input switching or the like.

(Application at p. 53-54.)

Thus, claims 52, 58, 63 and 72 are not rendered obvious by the purported combination of Browne, Lenihan, Suga and Ellis.

The Remaining Claims

All of the remaining dependent claims either incorporate additional features not disclosed, taught or suggested by the prior art and depend from independent claims which are believed to be patentable over the prior art as indicated above.

As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he telephone Applicants' attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

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Respectfully submitted,

By


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